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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/825,565 03/31/97 OYAMA

S 1095.1071/JD

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WASHINGTON DC 20001

LM02/0112

EXAMINER

WEINHARDT, R

ART UNIT

PAPER NUMBER

2764

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01/12/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/825,565

Applicant(s)

Oyama et al

Examiner

Robert Weinhardt

Group Art Unit

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☒ Responsive to communication(s) filed on Oct 26, 1999.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-14 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for a claim covering every conceivable means for achieving the recited purpose as set forth in the Office action mailed 6/28/99. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Applicant has amended claims 9-10 to remove recitation of the "processing means". Presumably this was to eliminate the use of the term "means" so that the claim literally would not be a "single *means* claim". However, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language.

Instant claim 9 as amended is drawn to any "terminal station", regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers*

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wherein "a DNA" and a result was recited. The CAFC stated in *Fiers* at 1606 "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived". See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single *means* claims even though "means" was not literally used. Thus, the deletion of "means" from claim 9 is not seen to overcome this rejection as the resultant claim yields a "terminal station" that achieves a result without defining what will do so.

Claim 10 is rejected as it depends on claim 9 and as the "encryption unit" recited still only clearly provides one concrete, explicitly recited element to the system.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 9 is not clear in that it only defines the "terminal station" in terms of functional language that does not precisely indicate the structural attributes of the terminal. See MPEP 2173.05(g).

Claim 10 is rejected because by its dependence it incorporates the language of claim 9.

As stated previously, in claims 11-14, the preambles call for allowing the customer to use "cyberspace banking services", but it is not clear how this is provided by the body of the claims. The end result of these methods is accepting or rejecting the account application. Even though the account may be opened via the open network, this does not guarantee that the new account is then operable to receive or perform "cyberspace banking services".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-4, 8-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Atkins as set forth in the Office action mailed 6/28/99.

Applicant argues that the system of Atkins communicates with other institutions to provide personal financial management services, but does not use these institutions to authenticate a new customer who wishes to have an account opened. Atkins however teaches a mortgage origination process including having the customer report his qualifications including financial background and assets owned. See col. 12 lines 5-26 of Atkins. Atkins also teaches that the central element of the HOPE account is the HOPE mortgage (col. 4 lines 16-19, col. 10 lines 25-26) and that the priority asset and liability allocation process is initiated when a client applies to open a HOPE account (fig. 10). In light of the teaching of verification of asset or liability holdings by communicating with other banks at col. 9 lines 31-34 and the readily recognizable criticality that this account and resultant mortgage be based on valid assets, clearly the verification performed at col. 9 refers to verification of assets for the purpose of establishing an account. A HOPE mortgage is central to the HOPE account as indicated above and thus there would be no point in establishing the account if assets and liabilities could not be verified as no valid mortgage could be issued.

Applicant further argues that the verifying of asset or liability holdings of Atkins is not the feature of "confirming the validity of an existing bank account". However, claim

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1 for example calls for "requesting the second bank system to make a confirmation of the existing bank account". Clearly, verifying the assets in an account at a second bank does at least confirm that the account exists. As the claims are broad concerning the specific type of account verification or confirmation performed and the content of the verification or confirmation response, the verification of Atkins is not excluded by the claims.

Concerning the combination of Weiss and Atkins, applicant argues that they do not teach "authenticating the customer online" for opening a new bank account. This language does not exactly appear in the claims. As mentioned above, claim 1 calls for "requesting the second bank system to make a confirmation of the existing bank account". Atkins shows the structure necessary to do so in fig. 2 and contains clear motivation to verify assets with other banks, and Weiss teaches applying for an account via customer PC's.

Applicant next appears to argue the limitations of "forwarding the existing account information received from the customer processing means to the second bank system over the second network and for opening the applied new bank account based on the confirmation of the existing bank account". However, the limitation of the content of what is forwarded, the entity it is forwarded to and the result of confirmation have been addressed in the prior Office action.

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Applicant argues that in the present invention the user's account information is confirmed "without the need for a certifying authority". This is not clearly the case as the second bank holding the existing customer account effectively becomes a certifying authority. Finally, with respect to the recitation of an "open network" and an "inter-bank network", these limitations have been addressed in the prior Office action.

7. Claims 5-7, 10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Atkins as applied to claims 1-4, 8-9, 11 above, and further in view of Micali as set forth in the Office action mailed 6/28/99.

With regard to this grounds of rejection, applicant relies on the arguments presented concerning Weiss and Atkins, which have been treated above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Money Laundering Alert article of 4/95 mentions that when opening large accounts, the customer should be asked for bank references and the banks should be asked questions about the customer's banking activity. The Money Laundering Alert of 10/96 suggests that banks compare information provided by a "cyberbanking" customer to other data such as a TRW report or the bank's own records.

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM. The examiner can also be reached at the e-mail address:


robert.weinhardt@uspto.gov

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768. Facsimile transmissions to this Group may be directed to (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

January 7, 2000


ROBERT A. WEINHARDT
PRIMARY EXAMINER